

Serial No.: 09/973,458  
Attorney Docket No.: F-113

Patent

## REMARKS

### 1. Status of Claims

Claims 13-37 were pending in the Application. Applicants have amended claim 37. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Applicants have amended the specification to include reference to the parent case as required.

### 2. Rejections under 35 USC § 112

In section 8 of the Office Action, the Examiner rejected Claims 13-37 under 35 U.S.C. 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants respectfully traverse the invention.

Regarding section 5.1 A-F, it is clear that one of skill in the art would find the subject matter sufficiently definite. The Examiner is apparently impermissibly attempting to require limitations of the preferred embodiment be read into the claim.

Regarding section G, it is clear that if the ad slogan is to be printed, such as after a successful test of actual feed direction, then the upside down print operation could be determined using the print location information as clearly claimed.

Regarding section 5.2, the invention as claimed clearly has utility as claimed. As is clear from claim 13, the postage printing system claimed is capable of printing postage indicia and has utility. Regarding claim 25, the method for operating the postage printing system describes indicia and certainly postage printer systems operated in such a way have utility. The related dependent claims are patentable for at least the reasons described above. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

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### **3. Double Patenting Rejections**

In section 6 of the Office Action, the Examiner rejected Claims 13-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,356,883.

Applicants respectfully traverse the rejection, but solely in order to expedite prosecution are enclosing a terminal disclaimer to overcome the rejection.

### **4. Rejections under 35 USC § 101**

In section 7 of the Office Action, the Examiner rejected Claims 13-37 under 35 U.S.C. 101, as allegedly directed to non-statutory subject matter.

Applicants respectfully traverse the rejection.

Applicants incorporate the comments above regarding the rejection under 35 USC section 112. Claims 13-24 recite a system. Claims 25-37 clearly recite processes that satisfy the requirements of 35 USC 101 and that clearly provide a useful, concrete, and tangible result including a novel, non-obvious method of operating a postage payment system. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998).

In section 7 of the Office Action, the Examiner rejected Claims 13-37 under 35 U.S.C. 101, as allegedly directed to non-statutory subject matter solely due to alleged failures to comply with other sections that specify patentability requirements.

Applicants respectfully traverse the rejection. Applicants have already addressed the other rejections and do not believe that such a duplicative rejection is properly advanced.

Accordingly, Applicants respectfully submit that claims 13-37 satisfy the requirements of 35 USC 101 and respectfully request that the Examiner withdraw the rejection.

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**5. Rejections under 35 USC § 103(a)**

In section 8 of the Office Action, the Examiner rejected Claims 13, 14, 25 and 26 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,168,804 to Lee, et al. in view of U.S. Patent No. 5,493,106 to Hunter or U.S. Patent No. 5,717,597 to Kara as suggested by U.S. Patent No. 5,831,554 to Storace and in further view of U.S. Patent No. 5,748,484 to Cannon, et al.

Applicants again respectfully traverse the multiple reference obviousness rejection.

Applicants note that the Examiner has admitted that none of the references not teach or suggest "determining if the postal indicia and the ad slogan may be printed in a single pass of the envelope through the print position of the postage printing system." In section 8.1.8, The Examiner seems to state that such functionality is obvious, using improper hindsight and the teachings of the present application. The Examiner did not provide a single reference to support such allegation.

Furthermore, Applicants submit that the references are not properly combined, and that one of skill in the art would not look to Cannon '484 to modify the other references. Even if the cited references were properly combined, there is no teaching or suggestion of the element cited above.

Accordingly, for at least the reasons stated above, claims 13, 14, 25 and 26 are patentable over the cited references.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection and submits that the invention as presently claimed in claims 13-37 is patentable and in condition for allowance.

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#### **6. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

#### **7. Authorization**

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-113.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-113.

Respectfully submitted,



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